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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,076	02/05/2001	Miklos Stern	7157-210	9554
27383	7590	05/02/2006	EXAMINER	
CLIFFORD CHANCE US LLP 31 WEST 52ND STREET NEW YORK, NY 10019-6131			LE, THIEN MINH	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,076

Applicant(s)

STERN ET AL.

Examiner

Thien M. Le

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/6/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 211-234 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 211-234 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The response to an election/restriction requirement filed on 2/6/2006 has been entered.

As a preliminary matter, the effective filing of this application is 2/05/2001. This is because: (i) 08/631,364 was issued on 5/9/2000; (ii) 08/506,574 was issued on 8/15/2000; and (iii) 08/394,813 was abandoned on 9/17/1997. None of the aforementioned parent applications was copending when this instant application is filed on 2/5/2001.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 211-212, 215-219, 222-229, and 231-234 are rejected under 35 U.S.C. 102(b) as being anticipated by 6,257,491 (Tan et al. – 6,257,491; herein after referred to as Tan).

Regarding claims 211 and 229, Tan discloses a visible laser diode 156 (figure 1); two micro-machined scanning mirrors 160 and 162 (figure 1; also brief descriptions of figure 1); and collecting optics (see figure 1 and its descriptions).

As can be seen, Tan discloses the claimed invention.

Art Unit: 2876

Regarding claims 212, 218, 219, and 231, Tan discloses that the "Light reflected from the indicia is collected by the collector optics 190 and is detected by the detector 185". (see col. 7).

Regarding claims 215, 217, 223, 227, 232, and 234 Tan discloses in col. 16 that "the mirror may be oscillated by any convenient means, including electromagnetically, electrostatically, bimetallically, or by means of the shape memory process. The mirror 14" (and indeed the mirror 14 shown in FIG. 9) is desirably rectangular, but could also be square, circular or elliptical. Laser speckle may be reduced by the use of several lasers."

Regarding claims 216, 228, and 233 Tan discloses in col. 10 that "the mirror 14 size may typically be between 1 and 3 mm. The mirror is suspended between opposite edges 13a, 13b of the frame by TiNi (or silicon) hinges 16a, 16b. Because the hinges are slightly flexible in torsion, the mirror is free to make slight oscillations about the hinge axis, in the directions indicated by the arrows 18."

Regarding claims 222, 224-225 and 226, Tan discloses in col. 17 that "the reader may also function as a portable computer terminal, and include a keyboard 1148 and a display 1149, such as described in the previously noted U.S. Pat. No. 4,409,470."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2876

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 213-214, 220, 221 and 230 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tan (Tan et al. – 6,257,491; herein after referred to as Tan; cited above) in view of Sharma et al. (Sharma et al. – US PG PUB 2002/0054188 A1; herein after referred to as Sharma).

Regarding claims 213-214, 220-221, and 230, see the discussions above regarding claims 211-212. The claim differs in calling for a scanning mirror that is made of silicon. However, this claimed limitation is not new. Reference to Sharma is

Art Unit: 2876

cited as an evidence showing the use of silicon type scanning mirror. Specifically, Sharma discloses that "A variety of optical scanning elements may be used in such a system, including scanning mirrors, scanning prisms and rotating mirror polygons. Furthermore, the system may be made compact by employing scanning micromachined mirrors that can be fabricated on silicon." (see paragraph 0043). It would have been obvious to replace Tan's scanning mirror with Sharma's scanning mirror. The modification merely a replacement of an art recognized equivalent which is well within the skill levels and expectations of an ordinary skilled artisan.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Le, Thien Minh
Primary Examiner
Art Unit 2876
April 29, 2006